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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,783	03/16/2000	Karl Hartmut Sauer	1.G164.186	1623

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 11/29/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/526,783

Applicant(s)

Sauer et al.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 7, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) 6, 10, and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I (claims 1-5 and 7-9) in the response filed September 7, 2001 (paper no. 7) is acknowledged. The traversal is on the ground(s) that "the inventions as defined by the Examiner are not independent and that they have common design and operational features." This is not found persuasive because of the following reasons. Regarding the apparatus claims, the Examiner's position is not that none of the claims include common design and operational features. This is clearly evident in that claim 1, which sets forth the common design and operational features is not considered to be part of or patentably distinct from any of the apparatus groups and thus will be examined with the elected group. However, applicant has clearly provided dependent claims to further patentably distinguish the invention over the prior art wherein the claims in the respective groups set forth to further define the invention in terms of design and operational features which are not common to the other groups. Therefore, the Examiner's position is that the groups define independent and distinct inventions for the reasons stated in the restriction requirement. However, if applicant believes that some of the groups are not directed to distinct inventions, applicant may identify which groups are not patentably distinct and claims directed to these groups will be examined together. It is noted, however, that such a statement may be used as an admission of obviousness and may be used in a

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rejection under 35 USC 103 (a) to reject all of the identified groups of inventions over prior art that meets one of the groups.

Regarding the method vs apparatus restriction, the Examiner maintains that the claimed method and apparatus claims set forth independent and distinct inventions, at least for the reasons set forth in the restriction requirement. Again, however, if applicant believes that some of the groups are not directed to distinct inventions, applicant may identify which groups are not patentably distinct and claims directed to these groups will be examined together. It is noted, however, that such a statement may be used, even regarding the method claims, as an admission of obviousness and may be used in a rejection under 35 USC 103 (a) to reject all of the identified groups of inventions over prior art that meets one of the groups.

The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement filed August 31, 2000 (paper no. 5) has been received and the references listed thereon have been considered.

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Abstract

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because of the use of "means" in line 6. ✓ ↙
Further, the use of "drill" appears to be contrary to the conventional use of the term, and it seems that the disclosed feature is a punch, not a drill. Appropriate correction is required. See MPEP § 608.01(b).

Specification

6. The disclosure is objected to because of the following informalities:

In general, the use of "plane" throughout the specification is unclear as to what is being described (e.g., is it intended to mean "planar"?). ✓

On page 2, line 25, "and" is improper, and it seems that it should be deleted and a comma --,-- should be inserted at the end of line 24; in line 27, the period "." is improper, and it seems

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that it should be changed to -- , and-- or the like; in line 29, "bloc" should read --block-- for clarity.

On page 3, line 5, the recitation "this die plates 04" is awkwardly worded and unclear.

On page 4, line 4 and throughout the specification, the use of "drill" appears to be inaccurate according to the conventional meaning of "drill", and is misleading since the feature appears to be a punch, not a drill.

On page 5, lines 21-22, the characters in the parentheses are unclear as to what is being described.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with vague and indefinite language and should be carefully reviewed. The following are examples of many of the occurrences of such language.

In claim 1, line 1, "plane" is vague and indefinite as to what is being set forth; in lines 1-3, the recitation "in particular defective products in the securities sector, such as banknotes and notes of value by perforating means" is vague and indefinite as to what is being set forth, particularly due to the use of "in particular" and "such as" wherein such phrases render the claim

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indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention, and because it is not clear as to whether "perforating means" is intended to be part of the claimed invention; in line 8, "drill" renders the claim vague and indefinite since it is not clear as to what structure is intended to be referred to thereby.

In claims 4 and 5, line 2, structural cooperation is not positively set forth for "a guide plate", particularly with respect to the paper drill; in line 4, structural cooperation is lacking for "a pressing plate".

In claims 7-9, line 1, the phrase "in one of claims 1-5" is vague and indefinite as to what is being set forth, particularly as to which claim "one" refers.

In claim 7, lines 1-2, "the pressing plate" lacks antecedent basis when this claim depends from claims 1-3; in line 2, "the receiving plate" lacks antecedent basis when this claim depends from claim 1-3.

In claim 8, line 2, "the guide plate" lacks antecedent basis when this claim depends from claim 1-3,

In claim 9, lines 1-2, the recitation "wherein the upper ends of the paper drills are open" is vague and indefinite when this claim depends from claim 3 and appears to be redundant with respect thereto; in line 3, structural cooperation is lacking for "support", particularly with respect to the drills.

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Claim Rejections - 35 USC § 102/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-3, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Schall et al., pn 4,509,396.

Schall et al. discloses a device with every structural limitation as best understood from the claims.

In the alternative, if it is argued that Schall et al. only discloses a single die plate and is required to disclose a plurality of die plates, the Examiner takes Official notice that such punch

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holding and guiding configurations are old and well known in the art and provide various well known benefits including providing separate components for easy manufacturing, maintenance and/or assembly/disassembly. Therefore, it would have been obvious to one having ordinary skill in the art to provide a plurality of die plates on the device of Shall et al. for the various known benefits including those described above.

Claim Rejections - 35 USC § 103

11. Claims 4, 5 and 7-9, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schall et al., pn 4,509,396.

Schall et al. lacks the specific features of the die plates including a guide plate, a pressing plate, and springs and stops therefor. Further, Schall et al. lacks a support. However, the Examiner takes Official notice that these features are known and are conventional and provide various well known benefits. For example, springs and stops provide well known operational components for punches for both retracting punches and limiting the amount of retraction so as to maintain a desired amount of travel for the punch; supports serving as containers are old and well known for receiving scrap from punching devices. Therefore, it would have been obvious to one having ordinary skill in the art to provide any or all of these features on the device of Schall et al. for the well known benefits including those described above.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
November 19, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.